

**RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3641**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

For: METHOD TO CONTROL REACTIONS
INVOLVING ISOTOPIC FUEL
WITHIN A MATERIAL USING
ORTHOGONAL ELECTRIC-FIELDS

Serial no. 09/ 748,691

Filed: 12/26/2000

This is a division of Serial no. 07/ 760,970
Filed: 09/17/1991

PAPER:

Group Art Unit: 3641
Examiner: Palabrica, R.J.

April 30, 2003

Commissioner of Patents and Trademarks
P.O.Box 1450 Alexandria, VA 22313-1450

**PETITION TO THE COMMISSIONER
PURSUANT TO 37 C.F.R. 1.181**

1. This Petition is made pursuant to 37 C.F.R. 1.181 to the Commissioner of Patents, and is made to invoke his supervisory authority to correct the situation with respect to the Examiner's failure to follow the normal standards of review (*infra*). Pursuant to 37 C.F.R. 1.181, there is no fee. This Petition is reasonable based on any of the several reasons stated below which are confirmed as fact and discussed in the Declaration supporting this Petition.

2. In the discussion below, reference is made to the Declaration of Dr. Mitchell Swartz (hereinafter called the "Swartz Declaration") dated April 30, 2003. It will be demonstrated that this motion is reasonable because of systematic failure to follow the standards of review, including failure to respond to submitted Declarations and arguments, failure to be accurate about purported "new material" from the Applicant, and improper use of NEW MATERIAL by the Examiner at Final designed to deprive the Applicant opportunity to respond.

♦ **POINT 1 - EXAMINER FAILED TO RESPOND TO APPLICANT'S ARGUMENTS**

3. The Examiner has not followed the normal standards of review regarding Applicant's responses which have proven the Examiner to be systematically disingenuous. The Applicant has made a complete, meticulous, and full reply to the Examiner. In said reply, the Applicant has answered all of the Examiner's criticism and duly and timely responded to each of the the Examiner's points. Declarations, peer-reviewed papers, and Exhibits were provided to demonstrate where the Examiner was in error. In this case, the Applicant did respond to the Examiner and every issue in the Office action. [Furthermore, the Applicant amended the claims in response to the Examiner's demands/suggestions.]

It is a standard of review that the Applicant is entitled to a response to his timely-submitted Declarations, pleadings and peer-reviewed papers submitted before FINAL which PROVED the Examiner was incorrect and made statements without foundation. In this case, the Examiner has NOT REPLIED to the Applicant's arguments before Final. In this case, the Examiner has ignored almost all of the Applicant's arguments, misquoted many of the rest, and has ignored the entire substantive timely-submission of Applicant's Declarations and peer-reviewed papers. In this case, the Examiner refused to respond to the substantive arguments.

The Examiner is supposed to "twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final."

In this case, it was once. The Examiner has defied the normal standards of review and has failed to explain why he deviated from said standards of review.

♦ **POINT 2 - EXAMINER ADDED NEW MATERIAL AT FINAL TO OBSTRUCT APPLICATION**

4. The Examiner has not followed the normal standard of review because he has --while ignoring the Applicant's detailed arguments-- added his own new material. Even though the Examiner's new material is flawed, and does not apply to the present invention, it IS NEW MATERIAL to which Applicant has not been allowed to respond (but did anyway).

NOTA BENE: Even though the Examiner did NOT respond to the Applicant, and even though the Examiner added NEW MATERIAL himself, he thus made his communication FINAL. Such an action is improper, unethical, inconsistent with the standard of review, and is not permitted.

"Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art,...."

The Examiner has defied the normal standards of review by introducing NEW MATTER and then refusing the Applicant opportunity to rebut his irrelevant, improperly entered, and immaterial NEW MATTER, and the Examiner has failed to explain why he deviated from said standards of review.

♦ POINT 3 - EXAMINER FAILED TO ALLOW HIS OWN SUGGESTIONS/ORDERS/REQUIREMENTS

5. The Examiner has defied the normal standards of review by not permitting minor changes in the Amendments which the Examiner suggested/ordered/requested. Applicant's amendments were consistent with 37 CFR 1.116 and adopted examiner's suggestions/demands and removed issues from appeal, raised no new matter, necessitated no new search, and was accompanied by affidavit and evidence submitted in a paper separate from the response.

The Examiner has also defied the normal standards of review by not responding to the Applicant who proved the changes were minor, not new material, and were consistent with what the Examiner suggested/ordered/requested.

The Examiner has failed to explain why he deviated from said standards of review.

The Examiner ignored amendments made in response to his suggestions/requirements/demands. They were made immediately and were made using identical minor material from the original specification and claims.

All amendments were made after suggested/ordered by the Examiner.
"A showing under 37 CFR 1.116(b) is required and will be evaluated by the examiner for all proposed amendments after final rejection except where an amendment ... adopts examiner's suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner"

In this case, the Examiner refused to allow Applicant to adopt examiner's suggestion.

In this case, the Examiner refused to allow Applicant to move issues for appeal.

♦ **POINT 4 - EXAMINER FAILED COMPLY WITH MPEP 707.07(J) AND 706.03(D)**

6. The Examiner previously stated over the telephone that he would help with the Amendment after the matters of 101, 102, 112 first paragraph and 103 were addressed. They have been addressed over and over again with sterling references, Exhibits, data, and Declarations which surmount the Examiner's writings, many made with foundations, and others which are mutually exclusive (as has been shown in the record). Therefore, to resolve this matter, Applicant called the Examiner and demonstrated where in the previous Communication, the Examiner ignored the Applicant's arguments rebutting the Examiners disingenuous and unscientific statements. When the absence of response in the Examiner's missives was pointed out to the Examiner in detail by a partial listing the peer-reviewed articles and Declarations and substantive arguments, the Examiner quickly and discourteously hung up the telephone. The Examiner refused to even state who his Supervisor was, only referring the Applicant to his "intermediate Supervisor" [who was not available by telephone before the time to FINAL expired, and who would previously not answer these questions {such as the number of Declarations required to prove utility}, either].

♦ **POINT 5 - EXAMINER FAILED TO CLARIFY ISSUES**

7. The Examiner has not followed the normal standard of review to allow Applicant to clarify the issues between Applicant and the Examiner. The standard of review is that before a final action is in order, a clear issue should be developed between the examiner and the patent owner. That was not allowed here. In the above-entitled action, the Examiner has refused to answer how many Declarations or peer-reviewed papers, written by the Applicant proving the Applicant was correct at the time of the filing of the original specification and claim, are required to refute the Examiner's inaccurate and disingenuous statements about operability.

In the above-entitled action, the Examiner has refused to answer how many Declarations are required to refute the Examiner's inaccurate statement about utility.

In the above-entitled action, the Examiner has refused to answer how many [~> three hundred so far] of papers submitted by the Applicant are required to overcome his groundless and flawed arguments about 112 first paragraph.

In the above-entitled action, the Examiner has refused to answer with specificity and itemization the Applicant's arguments regarding each of the other points of rejection.

Therefore, the Examiner has defied the normal standards of review and has failed to explain why he deviated from said standards of review.

WHEREFORE for the above reasons, the Applicant respectfully requests compliance with the standards of review cited above, and that the Office conform with 35 U.S.C. 134 requiring that the Applicant have his claims twice rejected before appeal to the Board of Patent Appeals and Interferences. In this case, the Applicant has not had his arguments addressed even once before the Examiner added his own new material at FINAL while ignoring many of Applicant's arguments.

WHEREFORE for the above reasons, the Applicant respectfully requests the Commssioner direct the EXAMINER to address the submitted unrebutted Declarations, Exhibits, and to provide clear substantive response to said arguments and Declarations, with emphasis to simply, resolve, and facilitate an Appeal, or issue the above-entitled application.

Respectfully submitted,



Mitchell R. Swartz, ScD, MD, EE
Post Office Box 81135
Wellesley Hills, Mass. 02481

Certificate Of Mailing
[pursuant MPEP Section 512 and 37 CFR 1.8(a)]

April 30, 2003

To Whom it Does Concern:

I hereby certify that this correspondence will be deposited with the United States Postal Service by First Class Mail, postage prepaid, in an envelope addressed to

"The Commissioner of Patents and Trademarks
P.O.Box 1450 Alexandria, VA 22313-1450" on the date below.

Thank you.

Sincerely,



April 30, 2003

M.R. Swartz

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April 30, 2003

DECLARATION OF DR. MITCHELL SWARTZ

I, Mitchell R. Swartz, declare that I am a citizen of the United States of America and the inventor of the invention described in the above-entitled application.

1. I have a background in electrical engineering, material science, electrophysicist and electrochemistry and have worked in this field for more than a decade, and have worked on experimental projects at the Massachusetts Institute of Technology, Massachusetts General Hospital and elsewhere.

2. I made a complete, meticulous, and full reply to the Examiner. In said reply, I answered all of the Examiner's criticisms, and duly and timely responded with Declarations, peer-reviewed papers, and Exhibits. They were described in pleadings written in English that explained where the Examiner was in error. The Examiner ignored most of my arguments and misstated others, and ignored all of the Declarations and Exhibits substantively.

3. The Examiner instead added his own new material. I responded again to show the Examiner his errors but he not only ignored all the Declarations and Exhibits, but refused to send my the checked off Forms 1449.

4. The Examiner would not clarify the issues for an Appeal.

5. The Examiner has refused to answer how many Declarations or peer-reviewed papers [proving I was correct at the time of the filing of the original specification and claims] are required to refute his statements about operability.

6. The Examiner has refused to answer how many Declarations are required to refute his statement about utility.



Mitchell R. Swartz, ScD, MD

I declare that all statements herein of my own knowledge are true and that all statements made on information and belief are believed to be true.

Signature of Inventor:
April 30, 2003



Mitchell R. Swartz, ScD, MD
Post Office Box 81135
Wellesley Hills, Mass. 02481

**RESPONSE UNDER 37 CFR 1.116
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Fax Transmission

From: Mitchell R. Swartz, MD, ScD

Questions? Call (781) 237-3625
or 239-1779 fax
(please call first)

To: **Patent Commissioner
Dr. Nicholas P. Godici**

**Group Art Unit: 3641
Examiner Palabrica**

Address: BOX AF
The Commissioner of Patents and
Trademarks
Washington, D.C. 20231

FAX
703-305-8825

AFTER FINAL

Date: **RESPONSE UNDER 37 CFR 1.116
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Time: **Pages: 8**

Re: Serial no. 09/ 748,691

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